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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

FINJAN, INC.,

Plaintiff,

vs.

PROOFPOINT, INC. AND ARMORIZE
TECHNOLOGIES, INC.,

Defendants.

Case No. 3:13-CV-05808-HSG

**PROOFPOINT INC. AND ARMORIZE
TECHNOLOGIES, INC.'S OPPOSITION
TO PLAINTIFF FINJAN, INC.'S
MOTION TO REQUIRE DEFENDANTS
TO CONFORM TO THE COURT'S
NOVEMBER 14, 2014 CASE
MANAGEMENT ORDER AND TO
STRIKE THEORIES NOT DISCLOSED
IN INVALIDITY CONTENTIONS**

1 Finjan requests the Court strike certain invalidity theories offered by Proofpoint's invalidity
 2 expert, Dr. Michael Franz, under 35 U.S.C. §§ 101, 103, and 112. Earlier today, the Court entered an
 3 order on Finjan's Motion To Strike Invalidity Contentions. *See* Dkt. No. 271. After the Court's Order,
 4 there remains the following obviousness combinations in Proofpoint's Final Election of Asserted Prior
 5 Art, each of which Dr. Franz also asserts in his report:

- 6 • For U.S. Patent No. 6,154,844 ("844 patent"), the obviousness combination of U.S. Pat.
 7 No. 6,253,370 ("Abadi"), U.S. Pat. No. 5,983,348 ("Ji"), U.S. Patent No. 6,128,774
 8 ("Necula"), ThunderBYTE Anti-Virus Utilities system as disclosed in "ThunderBYTE
 Anti-Virus Utilities USER MANUAL" and other publications ("ThunderBYTE"), U.S. Pat.
 No. 6,622,247 ("Isaak");
- 9 • For U.S. Patent No. 7,613,918 ("918 patent"), the obviousness combination of U.S. Pat.
 10 No. 7,587,755 ("Kramer"), U.S. Pat. No. 7,752,242 ("Satish"), U.S. Pat. No. 7,694,328
 11 ("Joshi"), Hagimont Jensen "Protection Wrappers: A Simple and Portable Sandbox for
 12 Untrusted Applications" ("Jensen"), U.S. Pub. No. 2004/0006706 ("Erlingsson"), Trend
 Micro's InterScan AppletTrap system as disclosed in Trend Micro's "InterScan
 AppletTrap: Eliminates Malicious Code" and other publications ("Trend Micro"); and
- 13 • For the '918 patent, the obviousness combination of U.S. Pat. No. 7,797,727 ("Miller"),
 14 Satish, Joshi, Kramer, Jensen, Erlingsson, Trend Micro.

15 At the scheduled December 9, 2015 Case Management Conference, Proofpoint intends to seek
 16 clarification on the impact of this Court's Order on Dr. Franz's expert report. In particular, in his
 17 report, Dr. Franz offers obviousness opinions for the asserted patents consisting of subsets of those
 18 references in the final election that were struck. These combinations render the asserted patents
 19 obvious, even without the references struck by the Court's Order. Proofpoint intends to seek
 20 clarification as to Dr. Franz's latitude to testify as to these combinations.

21 Finjan has interpreted the Court's Narrowing Order (Dkt. No. 98) in a manner that unduly
 22 constrains his role as an expert in providing independent opinions on invalidity. It is a well-settled rule
 23 in this District that experts may expound on obviousness and anticipatory references identified in a
 24 party's contentions. *See Largan Precision Co, Ltd. v. Genius Elec. Optical Co.*, No. 13-CV-02502-JD,
 25 2014 WL 6882275, at *7 (N.D. Cal. Dec. 5, 2014) ("To the extent Dr. Barbastathis now presents
 26 additional explanation as to why the language cited in the invalidity contentions, in his opinion,
 27
 28

renders obvious the claimed TTL range, that is consistent with the fact that expert reports are meant to provide more detail than contentions.); *see also Digital Reg of Texas, LLC v. Adobe Systems Incorporated*, No. CV 12–01971–CW (KAW), 2014 WL 1653131, at * 5 (N.D. Cal. Apr. 24, 2014) (“In patent litigation, expert reports are expected to provide more information than is contained in infringement contentions.”). Finjan alleges, however, that each obviousness combination, or theory of invalidity, limits Dr. Franz solely to use of each reference in that combination to show a claim limitation is present. Mot. at 6 (referring to a combination “A + B + C + D”). Finjan’s approach would limit Dr. Franz from, for instance, relying on references in the alternative (for instance, A + B + C or D). Finjan’s approach would also prohibit Dr. Franz from primarily relying on a subset of such references while relying on remaining references for background purposes, knowledge of person of ordinary skill, or motivation to combine (for instance, A + B, with C and D showing a motivation to combine A + B). *See Graham v. John Deere Co. of Kansas City*, 86 S.Ct. 684 (1966) (“Under § 103, the scope and content of the prior art are to be determined”). These opinions also appear in Dr. Franz’s report and, if permitted, he intends to present these at trial. For example, Dr. Franz opines that Miller alone or in combination with Kramer and Trend Micro render the patent obvious—a subset of the third obviousness combination listed above, and a theory of which Finjan had adequate notice. This is precisely the overly restrictive interpretation of the “combinations” requirement of the Narrowing Order Judge Freeman counseled against in footnote 2 of Dkt. No. 98, which states “an obviousness combination refers to a theory of invalidity and may contain additional references to support that theory.”

Furthermore, Finjan’s Section 101 and Section 112 arguments do not comport with this District’s case law. “Rule 3–3(d) governs invalidity contentions based upon 35 U.S.C. § 112(1) and requires that a party alleging such invalidity contentions provide ‘[a]ny grounds of invalidity based on . . . enablement or written description.’” *MediaTek Inc. v. Freescale Semiconductor, Inc.*, No. 11-CV-5341 YGR, 2014 WL 690161, at *6 (N.D. Cal. Feb. 21, 2014) (quoting Patent L.R. 3-3(d)). However, “the disclosure standard for invalidity contentions based upon enablement and

1 written description is lower than that required for a claim of obviousness” and need only “give the
2 other party enough notice that it can engage in full, timely discovery and litigate its case.”
3 *Medimmune, LLC v. PDL Biopharma, INC.*, No. C 08-5590 JF (HRL), 2010 WL 760443, at *3 (N.D.
4 Cal. Jan. 7, 2011); *see also MediaTek*, 2014 WL 690161, at *6. This is a low threshold to meet. *See*
5 *Medimmune*, 2010 WL 760443, at *4 (“While PDL claims that the disclosure leaves many important
6 questions unanswered, the Court concludes that the disclosure nonetheless meets the requirements of
7 the local rules.”); *Genentech, Inc. v. Trs. of Univ. of Pennsylvania*, No. C 10-2037 LHK (PSG), 2012
8 WL 424985, at *2 (N.D. Cal. Feb. 9, 2012) (finding disclosure “more than sufficient” to support an
9 expert’s discussion of invalidity based on section 112). Other than generalized references to
10 Proofpoint’s supplemental invalidity contentions, Finjan does not contend it lacked proper notice of
11 Dr. Franz’s opinions regarding subject matter patentability, indefiniteness, or written description
12 support of the asserted patents. Finjan has not even attempted to identify how Proofpoint’s disclosure
13 of Section 101 and 112 theories in its supplemental invalidity contentions differs from the opinions in
14 Dr. Franz’s report. Instead, Finjan states that these contentions lack sufficient disclosure. Finjan’s
15 challenges to Dr. Franz’s Section 101 and 112 theories are unpersuasive for multiple reasons.

16 First, the use of exemplary claims did not limit Proofpoint to only those claims for its
17 contentions that Finjan’s patents are invalid for failure to claim patentable subject matter Section 101.
18 Proofpoint generally reserved its rights to assert claims as invalid under Section 101 (Ex. A at 6), and
19 noted that Finjan’s patents failed the tests for patent eligibility “at least” as it relates to certain
20 exemplary claims (Ex. A at 40-42). A simple comparison of Proofpoint’s invalidity contentions with
21 Dr. Franz’s report show that this Section 101 theory was properly disclosed. *Compare* Ex. A at 40-41,
22 *with* Jariwala Decl., Ex. 1 at 98-99. Finjan cannot show how the differences in scope between claims
23 17 and 35 of the U.S. Patent No. 8,079,086 (“’086 patent”) are such that it was (as it admits) on notice
24 for Section 101 purposes on the latter but not the former. *Compare* ’086 patent claim 17 with claim
25 35. The same goes for the ’305 and ’408 patent, both of which were discussed in detail in Proofpoint’s
26 supplemental invalidity contentions and alleged to be invalid Section 101. *See* Ex. A at 40, 42.

1 Second, Proofpoint's supplemental invalidity contentions properly notified Finjan that
2 Proofpoint considered the terms "first rule set" and "suspicious computer operations" which appear in
3 asserted claims of the '844 and '086 patents, respectively, to be invalid under Section 112. For
4 example, Proofpoint identified "first rule set" as lacking support in the written description of Finjan's
5 '844 patent. Ex. A at 51. In addition, Proofpoint identified "suspicious computer operations" as being
6 indefinite or not adequately supported by the specification (as part of larger phrases) in three separate
7 places in its invalidity contentions. Ex. A at 47, 63-64.

8 Finally, Proofpoint's invalidity contentions put Finjan on notice that the claim terms in question
9 pursuant to 35 U.S.C. § 112. For example, both of the limitations Finjan cites for claim 1 of '305
10 Patent (Mot. at 4) were clearly identified as lacking adequate support in the specification. Ex. A at 63.
11 Furthermore, limitations of claim 24 of '086 Patent were also identified in Proofpoint's invalidity
12 contentions lacking adequate support in the specification. Ex. A at 63-64. Therefore, Finjan was on
13 notice that these terms lacked written description support and that Proofpoint would make that
14 assertion in this litigation.

15 For the foregoing reasons, Proofpoint respectfully requests the Court deny Finjan's Motion to
16 Strike.

1
2 Dated: December 4, 2015

Respectfully submitted,

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